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09/740,375	12/19/2000	Samuel N. Zellner	00382	4937

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/740,375

Applicant(s)

ZELLNER ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-20 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 5/31/05 is sufficient to overcome the 35 USC 103 rejection utilizing only Bandera and Goldhaber. A new reference has been added to the 35 USC 103 rejection.

#### ***Claim Objections***

3. Claim 14 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 14 does not clearly limit previous claim 13. Claim 14 is unclear as to whether the wireless service provider of claim 13 is being indicated in Claim 14 as also being an information provider or if the information provider of claim 14 was meant to replace the wireless service provider of claim 13. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 does not clearly limit previous claim 13. Claim 14 is unclear as to whether the wireless service provider of claim 13 is being indicated in Claim 14 as also being an

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information provider or if the information provider of claim 14 was meant to replace the wireless service provider of claim 13. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera (6,332,127) in view of Goldhaber (5,794,210) in view of Calvert (6,526,275).

Claim 1-14, 16-20:

Bandera discloses receiving current location of the user of a wireless device as the user moves about (col 2, lines 35-54); searching and selecting location specific advertisements for the current location of the user (Fig. 6; col 7, lines 9-20); and the utilization of a packet based message over a communication network (col 10, lines 4-8; col 1, lines 10-30). Bandera further discloses continuously monitoring user location and also sending multiple advertisements to the user (col 9, lines 30-41).

Also, Examiner notes that the Internet is a packet based communication network as stated in the cisco.com website [http://www.cisco.com/univercd/cc/td/doc/cisintwk/ito\\_doc/ip.htm](http://www.cisco.com/univercd/cc/td/doc/cisintwk/ito_doc/ip.htm):

**“Internet Protocol (IP)”**

The Internet Protocol (IP) is a network-layer (Layer 3) protocol that contains addressing information and some control information that enables packets to be routed. IP is documented in RFC 791 and is the primary network-layer protocol in

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the Internet protocol suite. Along with the Transmission Control Protocol (TCP), IP represents the heart of the Internet protocols. IP has two primary responsibilities: providing connectionless, best-effort delivery of datagrams through an internetwork; and providing fragmentation and reassembly of datagrams to support data links with different maximum-transmission unit (MTU) sizes.

#### **IP Packet Format**

An IP packet contains several types of information.”

Bandera further discloses matching user location and location based ads in a database (Fig. 6).

Bandera further discloses obtaining user location information without obtaining user identity information (col 2, lines 40-54).

Bandera further discloses utilizing digital audio and digital text (col 1, lines 26-30; col 1, lines 44-51).

Bandera further discloses targeting a user based on information about a user (col 1, line 65-col 2, line 10).

Goldhaber further discloses targeting users with content based on geographic areas (col 2, lines 27-35; col 15, lines 15-21) and that user geographic area information is known (col 13, lines 5-11).

Goldhaber discloses profiling a user, targeting content or advertising to a user based on known user information, maintaining user privacy, that user's can release user identifying information if the user so chooses (Abstract, second half, col 6, lines 22-45; col 7, lines 61-67; col 14, lines 10-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's advanced features for targeting a user based on user

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information to Bandera's targeting a user based on known information and user location information. One would have been motivated to do this in order to better provide relevant content and advertising to user(s).

Goldhaber further discloses the user pre-selecting criteria for content or advertising of interest (col 5, lines 5-16; col 18, lines 5-12).

Goldhaber further discloses obtaining second information about the identity of the user for a fee (col 6, line 64-col 7, line 5; col 17, lines 20-26; col 14, lines 7-10).

Goldhaber further discloses information provider who maintain and provide information about the user (Fig. 10; Fig. 7; col 15, line 55-col 16, line 5).

Goldhaber discloses, as referenced above, that the user can provide the user's identity when the user chooses to do. Furthermore, it is obvious that a user emergency can benefit from being able to identify who the user is in need. Therefore, it would be obvious that the user's identity can be provided in case of an emergency help request from the user. One would be motivated to do this that since the user himself has indicated that he is in dire need, the user is interested in receiving help.

Goldhaber further discloses soliciting second information from the user (Fig. 7; col 7, lines 7-20; col 12, line 45-col 14, line 16) and extracting second information from a message transmitted by the user (col 7, lines 7-20; col 12, line 45-col 14, line 16). Note that user identity in the form of user name or user email or user address information can be taken from the message the user sends to register for the service. Also, information about user identity such as user interests, user plans, user preferences, can be taken from communications of the user that are monitored.

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Bandera does not explicitly disclose receiving first information about a current location of the user from a wireless service provider for the wireless communication device.

However, Bandera discloses utilizing a service provider for user communications connectivity:

“(13) In the latter scenario, the remote computer may be connected to the Web server through a LAN or a WAN, or the connection may be made to an external computer (for example, through the Internet using an Internet Service Provider)” (col 6, lines 4-10).

Bandera further discloses that the user is mobile and that wireless devices, such as cellular telephones, can be utilized:

“(10) With the increasing mobility of today's society, the demand for mobile computing capabilities has also increased. Many workers and professionals are downsizing their laptop computers to smaller palm-top or hand-held devices, such as personal digital assistants (PDAs). In addition, many people now utilize computing devices, such as cellular telephones, within their automobiles to access the Internet and to perform various other computing functions. Hand-held computing devices including, but not limited to, PDAs and cellular telephones are often collectively referred to as "pervasive" computing devices. . .

(11) Accordingly, there is a need to enhance the efficacy of advertising to users accessing the Web via mobile Web clients” (col 2, lines 10-27).

Examiner notes that where a wireless device such as a cellular telephone is utilized that a wireless service must also be provided.

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Bandera further discloses that user position can be determined from GPS or from wireless service provider information such as cellular base station information or satellite beam communications information:

“(5) The mobile Web client 21 is configured to obtain location information from a Global Positioning System (GPS) 22. . . It will be understood that location information also may be obtained based upon an identification of a cellular base station or a satellite beam that is in communication with the mobile Web client 21. Although identification of a cellular base station or satellite beam may not provide as precise a location as a GPS, the location may be sufficiently precise to allow selection of advertising objects according to the present invention (col 4, lines 45-60);

(19) Furthermore, it is understood that the present invention is not limited to the use of a GPS for retrieving user location information. For mobile Web clients accessing a Web server via a telephone system, a Web server may trace the calling telephone number to determine the local exchange within which the mobile Web client is presently located. The local exchange could then be used to broadly determine the current location of the user;

(20) Alternatively, location information may be obtained based upon an identification of a cellular base station or a satellite beam that is in communication with the mobile Web client (21, FIG. 2). Although identification of a cellular base station or satellite beam may not provide as precise a location as a GPS, the location may be sufficiently precise to allow selection of advertising objects according to the present invention” (col 6, line 60-col 7, line 10).

Bandera further discloses that user location information need not be provided by the user/client:

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“(21) Note that in cases described above where the server queries the telephone exchange or where the location is determined by the cellular base station, this information is not actually transmitted by the client within the request” (col 7, lines 10-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Bandera’s determining of user location with cellular base station and satellite communication information can be provided by a wireless service provider.

As a further example of this, Calvert discloses providing time and location relevant advertising to a wireless user and that user location information can be provided by a wireless service provider:

“(11) Therefore, a need exists for a method and communication system for informing a user of a communication device where to obtain a product, wherein such method and system provide product information (e.g., advertisements) to the user at the time the user needs or likely needs such information and wherein the product information relates to product providers that are located, or at least have distribution locations, near the current location of the user (col 2, lines 45-53);

(46) For example, in accordance with known techniques, the system controller of a wireless system may periodically determine the locations of communication devices that are registered in the system. Upon determining such locations, the system controller forwards the locations to the context engine server which, upon receiving such locations, may automatically query providers of certain products, such as gasoline or food, that wireless device users are likely to be in need of and automatically generate a list of providers for conveyance to one or more of the communication devices. Thus, in this embodiment, the context engine server

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anticipates the communication device user's need for a product and provides the communication device with product information (advertisements) pertaining the potentially needed product (col 16, line 56-col 17, line 21);

(30) The approximate location of the communication device is preferably obtained from a wireless system controller in the event that the communication device is a wireless device or from the PSTN provider (e.g., telephone company) or Internet Service Provider in the event that the communication device is a wireline device. The approximate location of the communication device may be determined repeatedly (e.g., periodically when the communication device is a wireless device) or only once (e.g., some time during a communication when the communication device is a wireline device) (col 11, lines 40-51);

(5) The wireless portion of communication system 100 might comprise a two-way radio system, a cellular telephone system, a cordless telephone system (e.g., a wireless local loop), a home wireless network, a personal communication system (PCS), a personal area network (e.g., a Bluetooth network), a wireless data system, a paging system, or any combination thereof. Accordingly, the wireless communication devices 101, 102 may comprise mobile or portable radios, radiotelephones, pagers, wireless data terminals (such as palmtop computers, personal digital assistants (PDAs), or laptop computers that include PCMCIA cards for wireless communication), or any combination thereof' (col 4, lines 15-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Bandera's determining of user location with cellular base station and satellite communication information can be provided by a wireless service provider as

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disclosed in Calvert. One would have been motivated to do this in order to access user location information that be readily utilized for determining user location.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera (6,332,127) in view of Goldhaber (5,794,210) in view of Calvert (6,526,275) and in view of Bergh (6,112,186).

Bandera, Bergh, and Calvert disclose the method above.

Bandera further discloses providing relevant user information to advertisers for location based advertising (col 9, lines 345-55; col 6, lines 40-45).

Bandera does not explicitly disclose charging for user information.

However, Goldhaber discloses an auction to pay for user attention (col 4, lines 46-62) and that users can be paid for certain information (col 12, lines 52-60).

Additionally, Bergh discloses charging a fee for user information relevant to advertising (col 32, lines 50-61; col 33, lines 6-26; col 31, lines 44-49). Bergh also discloses tracking user location information (col 10, line 61-col 11, line 3) and that the user can be a wireless user (col 26, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Bandera can charge for the advertising relevant information. One would have been motivated to do this in order to generate revenue for information that is deemed of value to many advertisers.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-20 have been considered but are moot in grounds of the new rejection.

On page 7 of the Applicant's Amendment dated 5/31/05, Applicant states, "Bandera fails to at least disclose, teach, or suggest the feature of 'receiving first information about a current location of the user from a wireless service provider'". Applicant also states that Goldhaber does not disclose this feature. Examiner notes that these features have been added to the independent claims. Please see the rejection of the independent claims above starting with the section stating, "Bandera does not explicitly disclose receiving first information about a current location of the user from a wireless service provider. . ." to see how this feature is disclosed by the combination of the prior art.

Examiner further notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Hence, the combination of Bandera, Goldhaber, and Calvert renders obvious the Applicant's claimed features.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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7/20/05